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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,078	08/04/2003	Carl P. Decicco	PH-7477-NP	5245

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EXAMINER	
ROYDS, LESLIE A	

ART UNIT	PAPER NUMBER
1614	

NOTIFICATION DATE	DELIVERY MODE
01/15/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/634,078	DECICCO ET AL.	
	Examiner	Art Unit	
	Leslie A. Royds	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-9 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-9 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-9 are presented for examination.

Requirement for Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-7, drawn to a compound of formula (I) or a stereoisomer or pharmaceutically acceptable salt thereof and a pharmaceutical composition thereof, classified in class 514, subclasses 424 or 613, for example, depending upon the compounds used .

II. Claims 8-9, drawn to a method for the treatment of disorders responsive to the inhibition of beta-amyloid peptide production in a mammal in need thereof via the administration of a therapeutically effective amount of a compound of formula (I), classified in class 514, subclasses 424 or 613, for example, depending upon the compounds used.

The inventions are distinct, each from the other, for the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case, the presently claimed compound or pharmaceutical composition comprising a compound of formula (I) can be used in materially different processes of use, namely for the treatment of Alzheimer's disease or for the treatment of sporadic inclusion body myositis.

Because these inventions are distinct for the reasons given above, they require a different field of search (see MPEP §808.02) and they have acquired a separate status in the art because of their recognized divergent subject matter, the requirement for examination purposes as indicated is proper.

Election of Species Requirement

This application contains claims directed to patentably distinct species of:

(i) compounds of Formula (I) (claims 1-9); and

(ii) disorders responsive to the inhibition of beta-amyloid peptide production (claims 8-9).

Election of Invention I requires Applicant to make the following species elections:

(i) Election of a **single disclosed specie** of compound of Formula (I) from those specifically claimed in present claims 1-6.

Should Applicant elect a **single disclosed specie** of compound of Formula (I) that is a specific stereoisomer of a compound within the generic Formula (I), Applicant must explicitly provide:

(a) a structural depiction of the elected compound indicating, as appropriate, the specific stereoisomeric orientation of the atoms contained within the elected specie;

(b) the claims readable upon the elected specie; **and**

(c) if Applicant elects a specific stereoisomeric compound that falls within those species listed in claim 6, the chemical name of the elected compound must be provided in addition to the requirements of (a) and (b) listed *supra*.

Election of Invention II requires Applicant to make the following species elections:

(ii) Election of a **single disclosed specie** of compound of Formula (I) from those specifically claimed in present claim 1.

Should Applicant elect a **single disclosed specie** of compound of Formula (I) that is a specific stereoisomer of a compound within the generic Formula (I), Applicant must also explicitly provide a structural depiction of the elected compound indicating, as appropriate, the specific stereoisomeric orientation of the atoms contained within the

elected specie.

(iii) Election of a **single disclosed specie** of disorder responsive to the inhibition of beta-amyloid peptide production from those specifically claimed (see, e.g., claim 9).

Applicant is cautioned that the election of a particular specie of compound and/or disorder, wherein the elected specie(s) is/are not adequately supported by the accompanying specification, may raise an issue of new matter under the written description requirement of 35 U.S.C. 112, first paragraph.

The species are independent and/or distinct for the following reasons:

Regarding the species of compounds of Formula (I) (claims 1-9), the claimed compounds encompass such a breadth of compounds that are structurally and/or chemically distinct from any one single other compound encompassed by the claims such that a comprehensive search of the patent and non-patent literature for any one such compound would not necessarily result in a comprehensive search of any one or more of the other claimed compounds. Additionally, in consideration of the number and significant chemical and structural variability of compounds actually claimed by the instant genus as a result of the number and variation within each of the substituents contained within the claimed generic formula, the disparate nature and breadth of compounds encompassed by the claimed genus precludes a quality examination on the merits, not only because a burdensome search would be required for the entire scope of the claim(s), but also because the consideration of the findings of such a search for compliance with the statutes and requirements set forth under 35 U.S.C. 101, 102, 103 and 112, would be unduly onerous. Further, though Applicant has recognized a common functionality to the claimed compounds, e.g., that they are capable of treating disorders responsive to the inhibition of beta-amyloid peptide production when combined, it remains that the art does not necessarily recognize such a function as being shared by the entire claimed genus of compounds and, as a result, does not necessarily recognize their equivalency or interchangeability.

Regarding the species of disorders responsive to the inhibition of beta-amyloid peptide production (claims 8-9), the species are independent or distinct because such disorders as recited in the present claims for which the compound of Formula (I) must be therapeutically effective are each distinct from one another in etiology, pathophysiological manifestations, treatment protocol (i.e., duration of treatment, dosage amounts of active agent, frequency of treatment, etc.) and patient population such that a comprehensive search for the claimed compound in an amount effective to treat, for example, Alzheimer's disease, would not necessarily anticipate, suggest or render obvious the administration of the same or different compound in an amount effective to treatment an etiologically and pathophysiologically distinct disorder, such as Down's Syndrome. Notwithstanding that Applicant may have established an underlying commonality to this genus of disorders, namely that each is treatable via the use of a compound of Formula (I), it remains that the art does not necessarily recognize such a shared characteristic as being common to the entire genera of diseases encompassed by the claims, nor does the art necessarily recognize each as amenable to the same type of pharmacologic therapy. Each is considered patentably distinct from the others because the patient populations, dosage amounts and therapeutic protocol for treating the claimed disorders are each unique to the type of disorder being treated such that a comprehensive search for the claimed compounds in an amount effective for the treatment of a particular disorder in the prior art would not necessarily encompass a comprehensive search of the patent or non-patent literature for the claimed compound in an amount effective for the treatment of any one or more other disorders.

Applicant is REQUIRED to elect an invention and specie(s) in accordance with the instruction provided *supra* to which the claims shall be restricted if no generic claim is finally held to be allowable. A proper reply to this requirement is REQUIRED to include an identification of each species that is elected consonant with this requirement, a structural depiction of the claimed compound of formula (I) (including identification of each and every substituent), and a listing of all

claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered NON-RESPONSIVE unless accompanied by an election.

Currently, claims 1-9 are generic.

Upon the allowance of a generic claim, Applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. 1.141. If claims are added after the election, Applicant must indicate which are readable upon the elected species. Please see MPEP §809.02(a).

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should Applicant traverse on the ground that the inventions or species are not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 C.F.R. 1.48(b) and by the fee

required under 37 C.F.R. 1.17(i).

The Examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder**. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the Examiner withdraws the restriction requirement before the patent issues. See MPEP § 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie A. Royds whose telephone number is (571)-272-6096. The examiner can normally be reached on Monday-Friday (9:00 AM-5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on (571)-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Leslie A. Reyds
Patent Examiner
Art Unit 1614

January 3, 2008

ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER